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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/577,798	05/24/00	MERRIMAN D	11032/5

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EXAMINER	
HARLE, J	
ART UNIT	PAPER NUMBER
2166	5

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/577,798	MERRIMAN ET AL.	
	Examiner	Art Unit	
	Jennifer I. Harle	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☒ Interview Summary (PTO-413) Paper No(s). *5* .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☒ Other: *37 CFR 105* .

DETAILED ACTION

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed, because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

This Official Action contains numerous prior art rejections under both 35 U.S.C. §§ 102 and 103. These rejections were necessitated by the very broad claim language of Applicants. Each of the references utilizes different terms in describing Applicants' invention.

Applicants are reminded of their duty to disclose as required by 37 CFR 1.56.

Oath/Declaration

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The phrase "in that the invention encompasses an advertisement selection technique other than that which was originally claimed" fails to identify any error. It is merely a reiteration that Applicant "claimed more or less than" had been claimed in the original patent/application. Applicant has not identified any error which "causes the

patent to be deemed wholly or partly invalid." MPEP § 1402. Applicant should specifically set forth the error, not just the conclusion (i.e., the phrase).

Claims 1-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Information Disclosure Statement

Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,948,061, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

Applicant is required to supply copies of all prior art considered in the issued Patent No. 5,948,061, on an Information Disclosure Statement (1449).

Drawings

New formal drawings are required in this application because transfer of formal drawings is no longer done by the United States Patent and Trademark Office. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is not sufficient means to support the whereby/wherein clause that discusses displaying the advertising at the user node. This clause states that the content is displayed at the user node but the advertising node is responsive to the request to provide advertising content and there is no request explicitly going to the advertising node to trigger the advertising content.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 1, 3, 7, 9 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Kohda, et al. "Ubiquitous advertising on the WWW: Merging advertisement on the browser" (May 1996) (reference cited by Applicant).

As per claim 1, Kohda, et al. teaches a network supporting the hypertext transfer protocol comprising:

a user node having a browser program coupled to said network (Fig. 2), said user node providing request for information on said network (pg. 1495, col. 1, fourth paragraph);

a content provider node having a respective affiliate web site (Fig. 2 – Ordinary Web server and web page) responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content and a link message to said user node (Fig. 2);

an advertiser server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon information stored about said user node at said advertisement server node, and identify said advertiser node as said selected advertiser node to said user node (Fig. 2 Advertiser's Web server and an advertisement web page; pg. 1495, cols. 1-2, Sections 2.2 and 2.3, and pp. 1497-98, Section 3.2); and

whereby said advertising content from said selected advertiser node is displayed at said user node (pg. 1495, col. 1, Section 2.2).

As per claim 3, Kohda, et al. teaches selecting the advertiser node based on the characteristics of the user (pg. 1495, col. 1, Section 2.2 – "... tailor advertisements for individuals and their current interests ...").

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Kohda, et al. teaches a plurality of advertiser nodes (Fig. 2).

As per claim 9, Kohda, et al. teaches selecting the advertiser node based on the characteristics of the user (pg. 1495, col. 1, Section 2.2 – "... tailor advertisements for individuals and their current interests ...").

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

2. Claims 1, 5-7, 11, 13-14, 16, 20, 23, 27, 29-32, 39-40, 42-43, 45, and 49-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Wexler, U.S. Patent No. 5,960,409.

As per claim 1, Wexler teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Col. 2, lines 43-46);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 3, lines 36-44; Col. 4, lines 28-36);

an advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server node and identify said advertiser node as said selected advertiser node as said selected advertiser node to said user node (col. 4, lines 37-67); and

whereby said advertising content from said selected advertiser node is displayed at said user node (Col. 4, lines 4-7).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Wexler teaches a plurality of advertiser nodes (Col. 5, lines 25-65).

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

As per claims 5, 11, and 14, Wexler teaches a network in accordance with claims 1, 7, and 14, wherein said link message is an HTML tag (cols. 3-4, lines 59-9).

Claims 6, 12, and 15 are rejected for the same reasons as 5, 11, and 14

As per claims 16, Wexler teaches an advertisement server node selecting an advertising banner and the advertiser node being responsive to a request from the user node to identify a direct advertiser web site corresponding to the advertising banner (Col. 4, lines 54-67; Col. 5, lines 1-13; Col. 5, lines 36-43). Wexler also teaches that the advertiser node has a direct advertiser web site including direct advertising content corresponding to said advertising banner, the advertiser node responsive to a request from the user node to proide the direct advertising content corresponding to the selection of the advertising banner by the user, the advertiser node providing a feedback signal to the advertisement server node representing user transactions at the advertiser node (Cols. 4-5, lines 54-13).

As per claim 20, Wexler discloses a network in accordance with claim 16, further including:

Wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner (in the prior art, users can click through an ad banner to obtain additional information about

the advertiser – disclosed in Description of the Prior Art; Wexler, cols. 4-5, lines 54-13); and

An advertiser node having an advertiser web site including advertising content corresponding to said advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by said user (in the prior art, each advertiser typically maintains a web site including advertising content about their products and services which corresponds to the ad banners displayed on content web sites – disclosed in Description of the Prior Art; Wexler, cols. 4-5, lines 54-13 and col. 5, lines 36-43),

Whereby said advertising content from said advertiser node is displayed at said user node (once the advertiser's URL address is returned from the ad server to the user's browser, the user's browser would be redirected to the advertiser's web page, and advertising content from that page would be displayed on the user's computer – Description of the Prior Art; Wexler, cols. 4-5, lines 54-13 and col. 5, lines 36-43).

As per claims 21, 43 and 49, Wexler teaches a network in accordance with claim 16, wherein said link message is an HTML tag (cols. 3-4, lines 59-9).

Claims 22, 28, 31, 44, and 50 are rejected for the same reasons as set forth above in claims 21, 43, and 49.

As per claim 23, it is rejected for the same reasons set forth in claim 16.

As per claim 27 and 30 they are rejected for the same reasons set forth in claim 21.

As per claims 29 and 32 they are rejected for the same reasons set forth in claims 16 and 20.

As per claims 39, 42, and 45, it is rejected for the same reasons set forth in claims 16 and 20.

As per claims 40 and 43, it is rejected for the same reasons set forth in claim 21.

3. Claims 1, 3-7, 9-16, 18-23, 25-32, 34-37, 39-40, 42-45, and 47-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles, et al., U.S. Patent No. 5,933,811.

As per claim 1, Angeles teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Abstract; col. 1, lines 45-55; cols. 5-6, lines 62-3; col. 8, lines 38-46; col. 10, lines 43-54);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 2, lines 54-58 and lines 63-66; Col. 3, lines 41-65; col. 7, lines 53-60; col. 12, lines 13-35);

an advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server node and identify said advertiser node as said selected advertiser node as said selected

advertiser node to said user node (col. 7, lines 63-65; col. 8, lines 55-65, cols. 14-15, lines 59-31); and

whereby said advertising content from said selected advertiser node is displayed at said user node (Cols. 2-3, lines 66-2; col. 8, lines 62-65).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Angeles, et al. teaches that the "invention supports custom advertisements which can contain hyper-links to other information," i.e. these advertisements with their hyperlinks are equivalent to a plurality of advertiser nodes (Col. 4, lines 6-16).

As per claims 3 and 9, Angeles, et al. teaches an advertiser server node selecting the advertiser node based on the characteristics of the user (the concept of targeting is well known in the prior art – Description of the Prior Art; Col. 3, lines 58-62; Col. 8, lines 55-61; Col. 8, lines 55-62; Col. 14, lines 17-26 and 33-43).

Claims 4 and 10 are rejected for the same reasons set forth in claims 3 and 9.

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

As per claims 5, 11, and 14, Angeles teaches a network in accordance with claims 1, 7, and 13, wherein said link message is an HTML tag (cols. 1-2, lines 5-3; col. 6, lines 32-45; col. 12, line 61; col. 13, line 7; col. 15, lines 5-12; col. 18, lines 54-57).

Claims 6, 12, and 15 are rejected for the same reasons set forth above in claims 5, 11, and 14.

As per claim 16, Angeles teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Abstract; col. 1, lines 45-55; cols. 5-6, lines 62-3; col. 8, lines 38-46; col. 10, lines 43-54);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 2, lines 54-58 and lines 63-66; Col. 3, lines 41-65; col. 7, lines 53-60; col. 12, lines 13-35);

an advertisement server node storing information about said user node, said advertisement server node and responsive to a request from said user node based on said link message to select an advertising banner for said advertising space based upon the information stored about said user node at said advertisement server node and to reply to said request from said user node (col. 7, lines 63-65; col. 8, lines 55-65, cols. 14-15, lines 59-31),

whereby said advertising banner from said advertisement server node is displayed at said user node (Cols. 2-3, lines 66-2; col. 8, lines 62-65).

Claim 18 is rejected for the same reasons set forth in claim 3 and 9.

Claim 19 is rejected for the same reasons set forth in Claim 18.

As per claim 20, Angeles discloses a network in accordance with claim 16, further including:

Wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner (in

the prior art, users can click through an ad banner to obtain additional information about the advertiser – disclosed in Description of the Prior Art; Angeles, col. 4, lines 6-16); and

An advertiser node having an advertiser web site including advertising content corresponding to said advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by said user (in the prior art, each advertiser typically maintains a web site including advertising content about their products and services which corresponds to the ad banners displayed on content web sites – disclosed in Description of the Prior Art; Angeles, col. 15, lines 1-31),

Whereby said advertising content from said advertiser node is displayed at said user node (once the advertiser's URL address is returned from the ad server to the user's browser, the user's browser would be redirected to the advertiser's web page, and advertising content from that page would be displayed on the user's computer – Description of the Prior Art; Angeles, cols. 15, lines 1-31).

As per claim 21, Angeles teaches a network in accordance with claim 16, wherein said link message is an HTML tag (cols. 1-2, lines 5-3; col. 6, lines 32-45; col. 12, line 61; col. 13, line 7; col. 15, lines 5-12; col. 18, lines 54-57).

Claim 22 is rejected for the same reason as set forth in claim 21.

Claim 23 is rejected for the same reasons set forth in claim 16.

Claim 25 is rejected for the same reasons set forth in claim 18.

Claim 26 is rejected for the same reasons set forth in claim 19

Claim 27 and 30 are rejected for the same reasons set forth in claim 21.

Claim 28 is rejected for the same reason as set forth in claim 21.

Claims 29 and 32 is rejected for the same reasons set forth in claims 16 and 20.

Claim 34 is rejected for the same reasons set forth in claims 18 and 32.

Claim 35 is rejected for the same reasons set forth in claims 19 and 32.

Claims 36 and 47 are rejected for the same reasons set forth in claim 18.

Claims 37 and 49 are rejected for the same reasons set forth in claim 19.

Claim 39 is rejected for the same reasons set forth in claims 16 and 20.

Claim 40 is rejected for the same reasons set forth in claims 21 and 32.

Claim 44 is rejected for the same reasons as set forth in claims 21 and 32.

Claim 42 and 45 are rejected for the same reasons set forth in claims 16 and 20.

Claims 43 and 49-50 is rejected for the same reasons set forth in claim 21.

4. Claims 1, 3-4, 7, 9-10, 13, 16, 18-19, 20, 23, 25-26, 29, 32, 34-37, 39, 42, 45, and 47-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Minor, et al., U.S. Patent No. 5,740,252.

As per claim 1, Minor teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Col. 1, lines 20-23; col. 3, lines 37-43; col. 6, lines 18-25);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising

space for display of direct advertising content (col. 1, lines 36-39; col. 4, lines 19-28; cols. 5-6, lines 61-5 and cols. 6-7, lines 59-30);

an advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server node and identify said advertiser node as said selected advertiser node as said selected advertiser node to said user node (col. 4, lines 42-53; col. 6, lines 13-17; col. 7, 45-57); and

whereby said advertising content from said selected advertiser node is displayed at said user node (Col. 6, lines 6-17).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Minor, et al. teaches that the "reply may include a page with all the information necessary to compute a hyperlink transfer request at the user terminal," i.e. these replies with their hyperlinks are equivalent to a plurality of advertiser nodes (Col. 7, lines 59-64).

As per claims 3 and 9, Minor, et al. teaches an advertiser server node selecting the advertiser node based on the characteristics of the user (the concept of targeting is well known in the prior art – Description of the Prior Art; Col. 4, lines 42-53; Col. 6, lines 54-58; Col. 7, lines 49-57).

Claims 4 and 10 are rejected for the same reasons set forth in claims 3 and 9.

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

As per claim 16, Minor teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Col. 1, lines 20-23; col. 3, lines 37-43; col. 6, lines 18-25);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (col. 1, lines 36-39; col. 4, lines 19-28; cols. 5-6, lines 61-5 and cols. 6-7, lines 59-30);

an advertisement server node storing information about said user node, said advertisement server node and responsive to a request from said user node based on said link message to select an advertising banner for said advertising space based upon the information stored about said user node at said advertisement server node and to reply to said request from said user node (col. 4, lines 42-53; col. 6, lines 13-17, col. 7, lines 45-57),

whereby said advertising banner from said advertisement server node is displayed at said user node (Col. 6, lines 6-17).

As per claim 18, Minor teaches an advertisement server node in accordance with claim 16, wherein said advertisement server node selects said advertiser node based on the characteristics of said user (the concept of targeting is well known in the prior art

– Description of the Prior Art; Col. 4, lines 42-53; Col. 6, lines 54-58; Col. 7, lines 49-57).

Claim 19 is rejected for the same reasons set forth in claim 18.

As per claim 20, Minor discloses a network in accordance with claim 16, further including:

Wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner (in the prior art, users can click through an ad banner to obtain additional information about the advertiser – disclosed in Description of the Prior Art; Minor, cols. 6-7, lines 59-57); and

An advertiser node having an advertiser web site including advertising content corresponding to said advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by said user (in the prior art, each advertiser typically maintains a web site including advertising content about their products and services which corresponds to the ad banners displayed on content web sites – disclosed in Description of the Prior Art; Minor, cols. 5-6, lines 61-5; cols. 6-7, lines 59-57),

Whereby said advertising content from said advertiser node is displayed at said user node (once the advertiser's URL address is returned from the ad server to the user's browser, the user's browser would be redirected to the advertiser's web page, and advertising content from that page would be displayed on the user's computer – Description of the Prior Art; Minor, col. 7, lines 49-57).

Claim 21 is rejected for the same reasons set forth in claims 3 and 9.

Claim 23 is rejected for the same reasons set forth in claim 16.

Claim 25 is rejected for the same reasons set forth in claim 18.

Claim 26 is rejected for the same reasons set forth in claim 19.

Claims 29 and 32 are rejected for the same reasons as set forth in claims 16 and 20.

Claim 34 is rejected for the same reasons set forth in claims 18 and 32.

Claim 35 is rejected for the same reasons set forth in claims 19 and 32.

Claims 36 and 47 is rejected for the same reasons set forth in claim 18.

Claims 37 and 48 rejected for the same reasons set forth in claim 19.

Claim 39 is rejected for the same reasons set forth in claims 16 and 20.

Claim 40 is rejected for the same reasons set forth in claims 21 and 32.

Claims 42 and 45 are rejected for the same reasons set forth in claims 16 and 20.

Claim 43 is rejected for the same reasons set forth in claim 21.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoda, et al. "Ubiquitous advertising on the WWW: Merging advertisement on the

browser" (Applicant's submission). Kohda, et al. teaches as discussed above in the 102(a) rejection.

As per claims 2 and 8, Kohda, et al. does not specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser.

As per claims 16, 20, 23, 32 and 42, Kohda, et al. discloses as discussed above in the 102(a) rejection. Kohda, et al. does not disclose the specific display type/form/positioning of advertising, i.e. banner or interstitial, that would be selected. Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997, disclosed that banner ads are well known in the internet advertising field, that banner ads allow clicking through to the web site of the advertiser, and that in many instances substantially increased the advertiser's exposure. (Col. 3, lines 14-67); *see also* Peter N. Murray, U.S. Patent No. 6,061,659, filed June 3, 1997 (Cols. 1-2, lines 66-46) and Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997 (Col. 7, lines 59-65) (discussing banner advertisements and the problem with lack of targeting the consumer). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made

to select and display an advertising banner in order to increase the efficacy of contact with users.

6. Claims 2, 17, 24, 33, 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler, U.S. Patent No. 5,960,409; Angeles, et al., U.S. Patent No. 5,933,811; or Minor, et al., U.S. Patent No. 5,740,252.

As per claims 2, 8, 17, 24, 33, and 38 neither Wexler, nor Angeles, et al. nor Minor, et al. specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Moreover, this limitation is known in the prior art as "burnout," and reflects the well-known notion that continuous exposure to the same advertisement generally reduces the response rate to the advertisement. (Description of the Prior Art, col. 1, lines 54-59). Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser.

Claims 5-6, 11-12, 14-15, 21-22, 27-28, 30-31, 40-41, 43-44, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minor, et al. (U.S. Patent No. 5,740,252 as applied to claims 1,7,13, 16, 23, 29, 32, 42, and 45 above, and further in view of Draft HTML 2.0 Specification, September 22, 1995.

As per claims 5-6, 11-12, 14-15, 21-22, 27-28, 30-31, 40-41, 43-44, and 49-50, Minor does not teach the link message being an HTML tags or HTTP redirect. However, the use of HTML tags and HTTP redirect functions were well known in the art. The draft HTML 2.0 Specification teaches that a user browser may make a request to one server, which serves back a portion of a web page and a redirect message to the user that directs the user to a second server, which serves back the rest of the web page. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use an Internet standards track protocol for the internet community to facilitate easy and rapid communication to pull up web pages or portions of web pages.

7. Claims 32–49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. as applied to claims 1-5, 7-11, 19-29, 50-54 and 60 above, and further in view of Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997 or Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997 or Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997.

As per claims 32, 38 and 44, Kohda, et al. as discussed above does not teach the steps of sending a request from said user node to said advertisement server node responsive to selection of said advertising banner at said user node ... displaying said direct advertising content at said user node. However, these steps are merely a description of how a banner operates using click through technology. Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997, disclosed that banner ads are well known in the internet advertising field, that banner ads allow clicking through to the web site of

the advertiser, and that in many instances substantially increased the advertiser's exposure. (Col. 3, lines 14-67); *see also* Peter N. Murray, U.S. Patent No. 6,061,659, filed June 3, 1997 (Cols. 1-2, lines 66-46) and Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997 (Col. 7, lines 59-65) (discussing banner advertisements and the problem with lack of targeting the consumer).

The dependent claims 33-37, 39-43 and 45-49 are rejected for the same reasons as discussed above in relation to claims 2-6 and 8-12, 20-24, 26-30, and 51-54.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4, 7-10, 20, 32-39, 45-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-9, 19, 25-27, 32-34, 38-40 and 44-46 U.S. Serial No. 09/094,949. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been an obvious variation to have a link from the content provider affiliate node in lieu of advertiser node because it would enable the individual content provider to choose advertising which meets their criteria without reliance upon the advertiser. Moreover, it would have been an obvious various to have a link from the advertiser node in lieu of the content provider affiliate node because it would decrease the amount of storage space required by the content provider affiliate node, thereby decreasing costs to the consumer.

9. Claims 1-4, 7-10, 20, 32-39, 45-47 are provisionally rejected under the judicially created doctrine of obvious-type double patenting over claims 1-3, 6, 19-20, 41-44 of copending Application No. 09/362,008. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: targeted advertising

utilizing a user node, a content provider node, a proxy node (optionally), an advertiser node, and an advertisement server node. The main difference is that 09/362,008 claims collecting the prior activities of the user at the advertiser web site and broadly "retargeting" the advertising. However, the instant application clearly contemplates such action, albeitly more narrowly, where targeting is based on the characteristics of the user and on the number of times the direct advertising content has been previously displayed at the user node. Thus, it appears that "retargeting" describes the specific actions set forth in the instant application.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such art is relevant to show the state of the art, where such is claimed by Applicant and to show various portions of Applicant's claims.

Leaf, U.S. Patent No. 5,754,772, May 19, 1998;

Rakavy, et al., U.S. Patent No. 5,913,040, June 15, 1999; and

Levergood, et al., U.S. Patent No. 5,708,780, January 13, 1998.

This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to

the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:00 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703.308.5357 for regular communications and 703.308.5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.9700.

jih
April 10, 2001

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
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